

Application No. 10/797,481

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REMARKS

Claims 12-15 and 17-36 are pending. By this Amendment, claims 1-11 are canceled without prejudice. Also, claims 12 and 21 are amended, and new claims 25-36 are added. Claim 12 has been amended to delete certain language. Claim 12 has been further amended to recite specific biologically active agents, which are supported by the specification, for example, at page 6, lines 6-19. Claim 21 has been amended to clarify the nature of the immobilization referred to in the claim. The specification supports the amendment of claim 21, for example, at page 2, lines 3-5, page 3, lines 3-4, page 6, lines 5-11 and page 16, lines 6-7 as well as Fig. 3.

New claims 25, 26, 30 and 31 are supported by the specification, for example, at page 6, lines 6-19. New claim 27 is supported by the specification, for example, at page 6, lines 3-5. New claim 28 is supported by the specification, for example, at page 15, lines 24-27. New claim 29 is supported by the specification, for example, at page 16, lines 10-13. New claim 32 is supported, for example, by claim 12 as filed. New claim 33 is supported, for example, by claim 5 as filed. New claim 34 is supported, for example, by claim 2 as filed. New claim 35 is supported by the specification, for example, at page 16, lines 1-7. New claim 36 is supported by the specification, for example, at claim 8 as filed. No new matter is introduced by the claim amendments or the new claims.

Claims 1-15 and 17-24 stand rejected. Applicant respectfully requests reconsideration of the rejection based on the following remarks.

Claim Objection

The Examiner objected to claim 13 under 37 C.F.R. § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. With all due respect, Applicant believe that there has been a misunderstanding. Claim 12 recites a "biocompatible material" while claim 13 recites a "biocompatible metal." Thus, the claims do not have identical scope. Applicants respectfully request withdrawal of the objection to claim 13.

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Rejections Over Kambin

The Examiner rejected claims 1-5 and 8-10 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 6,175,758 to Kambin (the Kambin patent). To advance prosecution of this application, Applicants have canceled these claims without prejudice. Thus, the rejection is presently moot. Applicant respectfully requests withdrawal of the rejection of claims 1-5 and 8-10 under 35 U.S.C. § 102(b) as being anticipated by the Kambin patent.

Rejection Over Bowman et al.

The Examiner rejected claims 12-20 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,950,270 to Bowman et al. (the Bowman patent). To advance prosecution of the application, Applicants have amended claim 12 to more particularly point out their claimed invention. Also, Applicants have deleted some language that the Examiner asserted does not impose structural limitations on the claim, although Applicant maintains that the dimensional limitation did impose some degree of structural limitations. In view of the amendments, the Bowman patent does not render Applicant's claimed invention *prima facie* obvious. Applicant respectfully requests reconsideration of the rejection based on the following comments.

As amended, claim 12 recites a bioactive agent comprising bone morphogenic protein or a cytokine. The Examiner pointed to column 3, lines 13-25 of the Bowman patent for teachings relating to bioactive agents. With all due respect, the materials described in the Bowman patent seem to be passive agents to form a surface more conducive to integration of the device with the natural growth of tissue. The Bowman patent does not teach bioactive agents associated with a screw, as described in Applicant's specification. Certainly, the Bowman patent does not teach or suggest bone morphogenic protein or cytokines. Thus, based on the amendments, it is clear that the Bowman patent does not render Applicant's claimed invention *prima facie* anticipated. Applicants respectfully request withdrawal of the rejection of claims 12-20 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,950,270 to Bowman et al. (the Bowman patent).

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Rejection Over Cain

The Examiner rejected claims 21-23 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,334,205 to Cain (the Cain patent). To advance prosecution of the application, Applicant has amended claim 21 for clarity. In view of the clarification of claim 21, the Cain patent clearly does not render Applicant's claimed invention *prima facie* anticipated. Applicant respectfully requests reconsideration of the rejection based on the following comments.

The Cain patent is specifically directed to fixation "across the [sacroiliac] joint." See, for example, column 1, lines 55-57, column 2, lines 10-12, and throughout. The purpose of the fixation described in the Cain patent relates to a badly broken bone. In contrast, Applicant's claimed method is directed to immobilizing an unbroken bone to prevent pain associated with abrasion within the joint. Thus, in Applicant's method, the screw is inserted into the joint and not across the joint. In Applicant's approach, the screw does not pass through a bone. Please compare Fig. 5 of the Cain patent with Applicant's Fig. 3. In Fig. 5 of Cain, the fixation screws 58 and 50 are driven through the ilium bone 56 and into the sacrum bone 54. In contrast, in Applicant's method, the screw is driven in the space between the ilium and the sacrum, in other words into the joint not across the joint.

The Cain patent does not teach the placement of a screw into the sacroiliac joint, so the Cain patent does not *prima facie* anticipate Applicant's claimed invention. Since the Cain patent does not *prima facie* anticipate Applicant's claimed invention, Applicant respectfully requests withdrawal of the rejection of claims 21-23 under 35 U.S.C. § 102(b) as being anticipated by the Cain patent.

Rejection of Claims 6 and 7

The Examiner rejected claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over the Kambin patent in view of the Bowman patent. To advance prosecution of this application, Applicant has canceled claims 6 and 7 without prejudice. Since these claims have

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been canceled, their rejection is presently moot, and Applicant respectfully requests withdrawal of the rejection of claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over the Kambin patent in view of the Bowman patent.

Rejection of claim 11

The Examiner rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over the Kambin patent. To advance prosecution of this application, Applicant has canceled claim 11 without prejudice. Since this claim has been canceled, its rejection is presently moot, and Applicant respectfully request withdrawal of the rejection of claim 11.

Rejection of Claims 15-17

The Examiner rejected claims 15-17 under 35 U.S. C. § 103(a) as being unpatentable over Bowman. These claims depend from claim 12. The Examiner asserted that the features of these claims were matters of obvious design choice. Applicant has amended claim 12 for clarity. Applicant maintains that Bowman does not render Applicant's claimed invention *prima facie* obvious. Applicant respectfully requests reconsideration of the rejection based on the following comments.

First, as noted above, the Bowman patent does not teach bioactive agents as claimed in claim 12. In addition, since the procedures described in the Bowman patent is fundamentally different, the parameters of the devices used in the procedure are not a matter of design choice based on the fact that different design choices result from different objectives. Since the Bowman patent does not teach all of the elements of Applicants' claimed invention, the Bowman patent does not render Applicant's invention *prima facie* obvious. Applicant respectfully requests withdrawal of the rejection of claims 15-17 under 35 U.S. C. § 103(a) as being unpatentable over Bowman.

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Rejection of Claim 24

The Examiner rejected claim 24 under 35 U.S.C. § 103(a) as being unpatentable over Cain in view of U.S. Patent application publication number 2002/0099288 to Chang et al. (the Chang application). The Examiner cited the Chang application for teaching of real time imaging. Applicant maintains that the combined disclosures of the Cain patent and the Chang application does not teach or suggest the features of Applicant's claimed invention. Applicant respectfully requests reconsideration of the rejection based on the following comments.

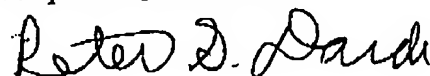
As noted above, Cain does not teach or suggest placement of a screw into a sacroiliac joint. The Chang application does not make up for this deficiency. Thus, the cited references alone or combined do not teach all of the claim elements. Furthermore, the Chang reference is directed to a joint replacement procedure, so the techniques are not directly applicable to an immobilization procedure. For these reasons, the combined teachings of the Cain patent and the Chang application does not render Applicant's claimed invention *prima facie* obvious. Applicant respectfully requests withdrawal of the rejection of claim 24 under 35 U.S.C. § 103(a) as being unpatentable over Cain in view of the Chang application.

## CONCLUSIONS

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



Peter S. Dardi, Ph.D.  
Registration No. 39,650

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Customer No. 62274  
Dardi & Associates, PLLC  
U.S. Bank Plaza, Suite 2000  
220 South 6th Street  
Minneapolis, Minnesota 55402  
Telephone: (404) 949-5730